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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,115	12/22/2000	Atsushi Terahara	2185-0497P	7905

2292 7590 10/06/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,115

Applicant(s)

TERAHARA ET AL.

Examiner

Julian A. Mercado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5-9, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12-14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Remarks

This Office Action is responsive to applicant's amendment filed July 21, 2003.

Claims 1-16 are pending, of which claims 14-16 are newly submitted. Claims 5-9, 11 and 12 have been withdrawn from consideration as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102 and 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 10 and 13-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Helmer-Metzmann et al. (U.S. Pat. 5,741,408).

The rejection is maintained for the reasons of record. The limitation "wherein the one or more blocks having substantially no sulfonic acid group is/are introduced from precursors having a weight-average molecular weight of not less than 2000" is considered to be a product-by-process limitation insofar as the "blocks" are "*introduced* from precursors", i.e. starting materials. [emphasis added] However, the limitation is absent of any structural features and as such, is not given patentable weight as the limitation does not give breadth or scope to the product claim. The claimed product appears to be the same or similar to the prior art product. In the event that any differences can be shown, such differences would have been obvious to the

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skilled artisan as a routine modification of the product absent of a showing of unexpected results.

In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985):

Applicant's arguments have been fully considered, however they are not persuasive.

Applicant submits that in Helmer-Metzmann (hereinafter the '408 patent, as cited by applicant), formula (I) shows that "the number of each repeating unit is 4 at most" and therefore, "it is apparent that the molecular weight of each repeating unit is less than 1000." (response, page 10, emphasis in original) In reply, the examiner notes that the amendment to the present claims recites that the *precursors* (and not the repeating units *per se*) have a molecular weight of not less than 2000. The examiner acquiesces with applicant's position that the repeating units in the '408 patent have a molecular weight of less than 1000, however, the examiner notes that a similar conclusion would apply to each of applicant's claimed repeating units: formula [1], page 5, formula [2] page 7, formula [3] page 9, and formula [4] page 12. Thus, contrary to applicant's assertion, the repeating units claimed by applicant are not patentably distinguishable from the repeating units disclosed in the '408 patent on the basis of molecular weight. For these reasons, for the reasons discussed above to the extent that the amended claims recite a product-by-process limitation, and for the reasons of record as set forth in the prior Office Action, paper No. 11, the claimed final product in the Helmer-Metzmann '408 patent appears to be the same or similar to that which is presently claimed.

Conclusion

IDS Paper Nos. 12, 13 and 14 (submitted April 14, 2003, May 2, 2003 and July 14, 2003, respectively) have been fully considered with the following exceptions:

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- a. JP 4-363121 and JP 5-15743, cited in IDS Paper No. 12, WO96/29360 and EP 0575807, cited in IDS Paper No. 14, have not been considered by the examiner as citation of these documents without its accompanying translation, English-language abstract or statement of relevance is not in compliance with MPEP 609. Applicant is requested to provide these related documents for the examiner's consideration. These documents are presently "lined-through" pending applicant's compliance.
- b. U.S. Pat. 5,438,082, U.S. Pat. 5,561,202, U.S. Pat. 5,834,566 and JP 10-45913, cited in IDS Paper No. 14, have been lined-through, as citation of these references in IDS Paper No. 14 is redundant over an identical citation in earlier IDS Paper No. 13.
- c. U.S. Pat. 5,741,408, cited in IDS Paper No. 14, has been lined-through as this document has already been made of record in Form PTO-892 (as attached to Office Action Paper No. 11).
- d. EP 0932213 and EP 0008894 are presently "lined-through" as these documents appear to have not been enclosed with its accompanying IDS Paper submission. Applicant is requested to submit a copy of these references for the examiner's consideration.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian A. Mercado whose telephone number is (703) 305-0511. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (703) 308-2383. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to be "J. Mercado", enclosed within a large, loopy oval shape.

Patrick Ryan
Supervisory Patent Examiner
Technology Center 1700